



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/027,664	12/20/2001	Stuart J. Solomon	12587-022001 / 01316-00/U	1128
26212 7590 04/08/2009 FISH & RICHARDSON P.C. P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022			EXAMINER BORISSOV, IGOR N	
			ART UNIT 3628	PAPER NUMBER
			NOTIFICATION DATE 04/08/2009	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PATDOCTC@fr.com

Office Action Summary	Application No. 10/027,664	Applicant(s) SOLOMON ET AL.	
	Examiner Igor N. Borissov	Art Unit 3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 December 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 36-51, 53-57, 59 and 60 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 36-51, 53-57, 59 and 60 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

Amendment received on 12/30/2008 is acknowledged and entered. Claim 58 has been canceled. Claims 36-51, 53-57, 59 and 60 are currently pending in the application.

Remarks

In last Office action of 11/13/2008 claims 36-51, 53-57, 59 and 60 have been indicated as allowable. However, upon further consideration and in view of newly obtained prior art a new ground(s) of rejection is made.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 59 and 60 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 59 and 60 are directed to a series of steps. In order for a series of steps to be considered a proper process under § 101, a claimed process should either: (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials). *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972). Thus, to qualify as patent eligible, these processes should positively recite the other statutory class to which it is tied (e.g., by identifying the apparatus which accomplishes the method steps), or positively recite the subject matter that is being transformed (e.g., by identifying the product or material that is changed to a different state). Claims 59 and 60 identify neither the apparatus performing the recited steps nor any transformation of underlying materials. The “business transaction management system” could be understood as merely a group of people performing a

Art Unit: 3628

task, and receiving information from a computer could be understood as merely reading displayed data, which would constitute trivial use of technology. As per claim mentioning a computer in preamble, mere recitation of the computer in the preamble does not cure § 101 issue unless the computer is recited in the body of the claim. Accordingly, Claims 59 and 60 identify neither the apparatus performing the recited steps nor any transformation of underlying materials, and, therefore, directed to non-statutory subject matter.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 36-46, 53-57, 59 and 60 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Brien (Computers In Business Management) in view of Gharavy (US 2003/0004840).

Claims 36 and 57.

O'Brien (Computers In Business Management), which appears to be published in 1979, teaches:

A method comprising:

receiving, electronically, at a computer system, a first transaction record from an organization, the first transaction record being received according to a first protocol, and the first transaction record having a first format and including first transaction data stored in the first format and describing a completed first transaction between the organization and a customer (billing a customer; p. 297; Fig. 10-10)

accessing, by the computer system and based on information in the first transaction record, a first business rule configured by the organization and describing a

second transaction expected to be completed between the organization and the customer in response to the completed first transaction, the first business rule including an acceptable time period in which the second transaction is expected to be completed (expected payment due; p. 298; Fig. 10-10)

receiving, by the computer system, a second transaction record from the organization including second transaction data describing completion of the second transaction and including a time attribute related to a time of completion of the second transaction (receiving a payment);

processing, by the computer system, the second transaction record using the first business rule, the processing including: based on the time attribute included in the second transaction record received from the organization, determining a time period between completion of the first transaction between the organization and the customer and completion of the second transaction between the organization and the customer (checking if said payment is overdue; p. 298; Fig. 10-10);

comparing the determined time period with the acceptable time period included in the first business rule (checking if said payment is overdue; p. 298; Fig. 10-10);

based on comparison results, determining, by the computer system, whether the second transaction between the organization and the customer was completed within the acceptable time period (checking if said payment is overdue; p. 298; Fig. 10-10);

processing the second transaction record based on whether the second transaction between the organization and the customer was completed within the acceptable time period (if the payment is late then producing delinquency notices; p. 298);

storing, by the computer system, at least some portions of the first transaction record and the second transaction record; and

displaying the results of the processing and storing, by the computer system, to at least one of the organization and the customer (Figs. 10-11, 10-12).

O'Brien does not explicitly teach that said formatting data includes converting, by the computer system, the first transaction data from the first format into another format.

Also, O'Brien does not specifically teach that said business rule is applicable to the customer located in jurisdiction different than that of the organization, and that the business rule includes an acceptable time period in which the second transaction is expected to be completed.

Gharavy teaches a method and system for performing collective validation of credential information, comprising: during said validation of transmitted data, converting data format in the format usable by the rule engine, for example *standard format* [0025]; [0105], thereby indicating "proper structure" feature. Furthermore, Gharavy teaches that said system is configured to require a regulatory jurisdiction when defining credential types [0030]. Specifically, certain requirements associated with a particular jurisdiction (residency) must be addressed [0033]; [0041]. Gharavy also teaches that said rules encompass specific time periods during which the responsive action should be performed [0036]; [0040]; [0044].

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify O'Brien to include converting, by the computer system, the first transaction data from the first format into another format, as disclosed in Gharavy, because it would advantageously simplify the processing of said data, as well as allow to accommodate clients executed on various platforms. As per addressing jurisdiction issues, the motivation would be to provide services in compliance with current local and Federal regulations. Furthermore, so as this is a case where the improvements are no more than the predictable use of prior art elements according to their established functions, no further analysis for "motivation to combine" is required by the Examiner. *KSR*, 127 S.Ct. at 1740, 82 USPQ2d at 1396.

Claims 37-38. O'Brien teaches the method of claim 36 further comprising:
determining in an automated manner whether the first business rule is satisfied by the second transaction data (checking if the payment is late p. 298);
accessing, when the first business rule is satisfied, a second business rule configured by the organization and describing a third transaction expected to be

Art Unit: 3628

completed between the organization and the customer in response to the completed second transaction (if the payment is late then producing delinquency notices; p. 298); receiving a third transaction record from the organization including third transaction data describing completion of the third transaction (producing delinquency notices; p. 298). As per “format” feature per se, same reasoning as applied to claim 36.

Claims 39-40. O'Brien teaches the method of claim 36 further comprising: determining whether the first business rule is satisfied by the second transaction data; and informing the organization of whether the first business rule is satisfied. As per “format” feature per se, same reasoning as applied to claim 36.

Claim 41. O'Brien teaches the method of claim 36 further comprising: receiving a third transaction record from the organization, the third transaction record being received according to the first protocol, and the third transaction record having the first format and including third transaction data stored in the first format and describing a completed third transaction between the organization and the customer (late payment; p. 298); determining that the third transaction is an unexpected transaction (late payment), an unexpected transaction being a transaction that is expected to succeed a given transaction that has not been completed; and informing the organization that the third transaction is an unexpected transaction (producing delinquency notices; p. 298). As per “format” feature per se, same reasoning as applied to claim 36.

Claims 42-46. Same reasoning applied to Claim 36. Furthermore, teachings of O'Brien in view of Gharavy would allow the repetition of the recited steps.

Claim 53. O'Brien teaches: processing the second transaction record; sending a message to the organization indicating that the second transaction between the organization and the customer was not completed within the acceptable time period; and storing a record indicating that the second transaction between the organization and the customer was not completed within the acceptable time period (producing delinquency notices; p. 298).

Claims 54 and 55. Same reasoning as applied to claim 36.

Claim 59.

O'Brien teaches:

maintaining, by a business transaction management system, a database of configurable business rules that control transactions between an organization and clients of the organization, the configurable business rules being based on preferences of at least one of the organization and the clients and based on rules governing transactions between the organization and the clients, wherein the configurable business rules include:

a first business rule that controls transactions between the organization and a first client, the first business rule being configured based on preferences of at least one of the organization and the first client and at least one rule governing transactions between the organization and the first client, and

a second business rule that controls transactions between the organization and a second client, the second business rule being configured based on preferences of at least one of the organization and the second client and at least one rule governing transactions between the organization and the second client, wherein:

receiving, at the business transaction management system from a first computer system associated with the organization, a message identifying a business transaction between the organization and a client, the business transaction including a request business transaction and a response business transaction that is performed by the

Art Unit: 3628

client in response to the request business transaction as part of the business transaction;

based on the message identifying the business transaction, determining, by the business transaction management system, whether the client associated with the business transaction is the first client or the second client (checking identity of a customer, a customer account number);

conditioned on a determination that the client is the first client, accessing, by the business transaction management system, the first business rule that controls business transactions between the organization and the first client (checking the status of the identified account);

conditioned on a determination that the client is the second client, accessing, by the business transaction management system, the second business rule that controls business transactions between the organization and the second client (checking requirements for timely payment);

based on the accessed business rule, identifying, by the business transaction management system, a time period in which the response business transaction to the request business transaction is due from the client, wherein the time period is based on a preference of the organization in receiving responses to request business transactions and at least one rule governing transactions between the organization and the client, and the time period is different based on whether the accessed business rule is the first business rule or the second business rule (checking requirements for timely payment);

sending, from the business transaction management system to a second computer system associated with the client, a message identifying the request business transaction and the time period in which the response business transaction to the request business transaction is due from the client (sending a billing statement);

monitoring, by the business transaction management system, messages received from the second computer system associated with the client for a message related to the response business transaction;

based on the monitoring, determining, by the business transaction management system, whether a message related to the response business transaction has been

received from the second computer system associated with the client within the time period (checking if said payment is overdue; p. 298; Fig. 10-10);

conditioned on a determination that a message related to the response business transaction has been received from the second computer system associated with the client within the time period, processing, by the business transaction management system, the business transaction between the organization and the client based on the message related to the response business transaction (processing the payment); and

conditioned on a determination that a message related to the response business transaction has not been received from the second computer system associated with the client within the time period:

sending, from the business transaction management system to the second computer system associated with the client, a reminder message indicating that the response business transaction has not been received (if the payment is late then producing delinquency notices; p. 298); and

sending, from the business transaction management system to the first computer system associated with the organization, an error message indicating that the response business transaction has not been performed by the client (creating accounts receivable aged trial balance; Fig. 10-12).

O'Brien does not explicitly teach that said formatting data includes converting, by the computer system, the first transaction data from the first format into another format.

Also, O'Brien does not specifically teach that said business rule is applicable to the customer located in jurisdiction different than that of the organization, and the second jurisdiction is different than the first jurisdiction, and the at least one rule of the second jurisdiction is different than the at least one rule of the first jurisdiction.

Gharavy teaches a method and system for performing collective validation of credential information, wherein said system is configured to require a regulatory jurisdiction when defining credential types [0030]. Specifically, certain requirements associated with a particular jurisdiction (residency) must be addressed [0033]; [0041]. Gharavy also teaches that said rules encompass specific time periods during which the responsive action should be performed [0036]; [0040]; [0044].

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify O'Brien to include that the customer located in jurisdiction different than that of the organization, and the second jurisdiction is different than the first jurisdiction, and the at least one rule of the second jurisdiction is different than the at least one rule of the first jurisdiction, as suggested in Gharavy, for the benefit of providing services in compliance with current local and Federal regulations. Furthermore, so as this is a case where the improvements are no more than the predictable use of prior art elements according to their established functions, no further analysis for "motivation to combine" is required by the Examiner. *KSR*, 127 S.Ct. at 1740, 82 USPQ2d at 1396.

Claim 60. Same reasoning as applied to claim 59.

Claims 47-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Brien (Computers In Business Management) in view of Gharavy (US 2003/0004840) and further in view of Al Senia (The Internet Forefront).

Claim 47. The combination of O'Brien in view of Gharavy teaches all the limitations of claim 47, except explicitly teaching providing the organization electronic access to transaction records for the series of successive transactions.

Al Senia (The Internet Forefront) which appears to be published on October, 2000, teaches how utility company switching to e-commerce and interacting with customers over the Internet, thereby suggesting said feature.

It would have been prima face obvious to one having ordinary skill in the art at the time the invention was made to modify the combination to include providing the organization electronic access to transaction records for the series of successive transactions, as suggested in Al Senia, because it would advantageously allow to reduce cost, as specifically stated in Al Senia. Furthermore, in this case, each of the elements of the cited references combined by the Examiner performs the same function when combined as it does in the prior art. Thus, such a combination would have yielded

Art Unit: 3628

predictable results. See *Sakraida*, 425 U.S. at 282, 189 USPQ at 453. Therefore, Supreme Court Decision in *KSR International Co. v. Teleflex Inc.* (KSR, 82 USPQ2d at 1396) forecloses the argument that a specific teaching, suggestion, or motivation is required to support a finding of obviousness. See the recent Board decision *Ex arte Smith*, --USPQ2d--, slip op. at 20, (Bd. Pat. App. & Interf. June 25, 2007).

Claims 48-51. Same reasoning as applied to claim 47.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Igor Borissov whose telephone number is 571-272-6801. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Igor N. Borissov/

Primary Examiner, Art Unit 3628

04/02/2009